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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/656,686	09/04/2003	Thomas J. Friedman	SP03-107 (WJT003-0045)	8554
22928	7590	06/06/2006	EXAMINER	
CORNING INCORPORATED			IVEY, ELIZABETH D	
SP-TI-3-1				
CORNING, NY 14831			ART UNIT	PAPER NUMBER
			1775	
DATE MAILED: 06/06/2006				

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 10/656,686	Applicant(s) FRIEDMAN ET AL.	
	Examiner Elizabeth Ivey	Art Unit 1775	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 21 April 2006.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1,2,6,7,17 and 20-22 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1,2,6,7,17 and 20-22 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Claim Rejections - 35 USC § 112

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claims 1-2, 6-7, 17 and 20-22 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. Applicant does not provide any reference to the term "regular" or any definition of the term "regular" in the specification.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for a patent.

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Art Unit: 1775

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 1-2, 6-7 and 22 are rejected under 35 U.S.C. 102(a) or (e) as being anticipated by U.S. Patent 6,461,709 B1 to Janssen et al.

Regarding claims 1-2, 6-7 and 22, Janssen discloses a glass sheet covered with removeable protective sheets on both sides of the glass sheet either of which may or may not contain embossed images or graphics (column 3 lines 29-32, column 6 lines 48-50, column 16 lines 5-7, column 19 lines 59-62 and figure 13. An image embossed on the sheets and deposited on both sides of the glass would have an inverse and therefore different position on each side.

Claims 1 and 6 are rejected under 35 U.S.C. 102(b) as being anticipated by U.S. Patent 4,944,822 to Ishikawa et al.

Regarding claims 1 and 6, Ishikawa discloses plastic cover films (3) and (33) of materials such as polyethylene, polyurethane, nylon, polyester or other plastics for a sheet material such as glass. Any film would ultimately be removeable from the glass and either side of the glass plate may be the top or the bottom because the top and bottom of the plate are not distinguished from one another. The cover films have a set (regular) embossed surface roughness of .5-70 μ m (column 4 lines 11-26, column 9 lines 7-8 and 17 figures 5 and 6).

Art Unit: 1775

Claims 1-2 and 6-7 are rejected under 35 U.S.C. 102(b) as being anticipated by U.S. Patent 5,188,692 to Horvath.

Regarding claim 1-2 and 6-7, Horvath discloses a laminate of a film of polyvinyl butryl or polyurethane and polyethylene terephthalate between glass plates and another similar film on the opposite side of one of the glass plates. Any film would ultimately be removeable from the glass. The films may be smooth or embossed and either side of the glass plate may be the top or the bottom because the top and bottom of the plate are not distinguished from one another (abstract and column 1 lines 48-67 and column 5 lines 3-11).

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.

Art Unit: 1775

2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

Claims 17 and 20-21, are rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent 2,556,529 to Farrell in view of U.S. Patent 6,461,709 B1 to Janssen et al.

Regarding claims 17 and 20-21, Farrell discloses a protecting container for fragile and breakable articles such as glass, and particularly a shipping carton for glass sheets; which would include glass sheets used in a liquid crystal display (column 1 lines 1-4). Farrell discloses the carton to be preferably of rectangular formation and composed of four side walls, a top and a bottom (column 2 lines 24-29) and glass sheets mounted next to each other within the carton (column 2 line 41-44 and figure 3) and discloses a method of protecting the glass sheets supporting them from breakage or damage (column 2 lines 54-55 and column 3 line 1). Farrell does not disclose removable protective films on the top and bottom of the glass sheets. Janssen discloses a glass sheet for windows displays and signage covered with removeable protective sheets on both sides of the glass sheet either of which may or may not contain embossed images or graphics (column 3 lines 29-32, column 6 lines 48-50, column 16 lines 5-7, column 19 lines 59-62 and figure 13. An image embossed on the sheets and deposited on both sides of the glass would have an inverse and therefore different position from the opposite side. Janssen discloses the film may be made from materials such as polyolefins and polyethylenes and blends thereof (column 5 lines 5-11). Because Janssen's films are used to protect the glass sheet, it would have been obvious to a person having ordinary skill in the art at the time of the invention to utilize the

Art Unit: 1775

glass sheets of Janssen with the protective films in the container of Farrell to keep the sheets of glass from scratching during transit.

Response to Arguments

The examiner acknowledges applicant's cancellation of claims 8-10, 18-19 and 23-25 and amendment of claims 1-2, 6-7, 17 and 22.

The examiner accordingly withdraws the objection to claim 8.

Applicant's arguments filed April 21 2006 have been fully considered but they are not persuasive and are additionally moot in view of the new ground(s) of rejection.

Regarding applicant's argument that the addition of the term regular distinguishes applicant's claims over the prior art, because applicant does not provide any reference to the term regular or any definition of the term regular, the applicant has added new matter requiring the application of a 112 1st paragraph rejection of all claims. In subsequent consideration of the new matter, the examiner must assume the broadest definition of the term, which includes according to Meriam –Webster OnLine; anything “formed, built, arranged, or ordered according to some established rule, law, principle or type”.

Art Unit: 1775

Conclusion


Any inquiry concerning this communication or earlier communications from the examiner should be directed to Elizabeth Ivey whose telephone number is (571) 272-8432. The examiner can normally be reached on 7:00- 4:30 M-Th and 7:00-3:30 alt. Fridays.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jennifer McNeil can be reached on (571) 272-1540. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.



Elizabeth D. Ivey



JENNIFER C. MCNEIL
SUPERVISORY PATENT EXAMINER
5/23/06